

REMARKS

The Applicants will address each of the Examiner's objections and rejections in the same order as they were presented.

Claim Rejection under 35 U.S.C. § 112

The Examiner rejected claim 14 as having insufficient antecedent basis for the phrase "said aggregating instructions" in line 1 of claim 14. Claim 14 has been amended to correct a typographical error. Claim 14 now depends from claim 13. Furthermore, claim 14 has also been amended to maintain consistent use of the phrase "instructions for aggregating" found in claim 13.

Claim Rejections under 35 U.S.C. § 103

To establish a prima facie case of obviousness, three basic criteria must be met, namely:

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- 2) There must be a reasonable expectation of success; and
- 3) The prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.¹

The Examiner has rejected all of the pending claims 1-26 under 35 U.S.C. § 103(a). For each rejection of claims 1-26 the Examiner relies upon the teachings of the publication entitled "ParkStone Introduces New Hand-Held, Electronic Point-of-Care Tool Based on Microsoft Windows", PR Newswire, 7/12/99, 3 pgs, by Anonymous (hereinafter "ParkStone"). Furthermore, for each rejection of claims 1-16, 20, and 22-26 the Examiner relies upon the combined teachings of ParkStone with, at least, the publication entitled "Apothecary.now", Hospitals & Health Networks, July 1999, Vol. 73, No. 7, pages 34-40, by Menduno, Michael (hereinafter "Menduno"). Still further, for each rejection of claims 9, 15, and 17-21 the Examiner relies upon the teachings of at least one of the above cited references together with the publication entitled "Medical Technology Start-Up Provides Medical Professionals With Mobile Point of Care Automation", Business Wire, 7/19/99, 2 pgs, by

¹ See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Anonymous (hereinafter “med-I-nets”). Finally, the Examiner relies upon the teachings of the publication entitled “Easing Workflow in the Palm of Physicians’ Hands”, Health management Technology, November 1999, Vol. 20, No. 10, pages 48-49, by Parker, Glenn M. (hereinafter “Parker”) in combination with at least one of the above cited publications in rejecting claims 4-7 and 11. Accordingly, all of the pending claims were rejected as obvious over Parkstone (July 12, 1999), Menduno (of July 1999), med-I-nets (July 19, 1999), and/or Parker (November 1999). The earliest of these publication dates back to July 1999.

As will be shown below, the present invention was conceived of prior to July 1999 and was diligently pursued from prior to July 1999 until it was constructively reduced to practice on January 20, 2000, as required by 37 C.F.R. § 1.131. In other words, a “swearing back” of the invention effectively removes the abovementioned publications as 35 USC 103(a) references.

The applicants direct the Examiner’s attention to the Rule 1.131 Declarations, submitted concurrently herewith, which demonstrate that the invention claimed in the above-identified application was conceived prior to July 1, 1999. For example, paragraphs 7 to 9, as supported by Exhibits A-C, of the inventors’ Rule 1.131 Declarations describe the prior conception of each element of the independent claims of the present invention. Specifically, paragraph 7 of the inventors’ Rule 1.131 Declarations discloses that the inventors conceived of the medical data distribution system, as claimed in the independent claims of the present invention, prior to July 1999.

Furthermore, the Rule 1.131 Declarations demonstrate that the applicants and their agents acted with diligence from prior to July 1, 1999, continuously up to the date of filing the application with the United States Patent and Trademark Office on January 20, 2000. Paragraphs 10 to 23 of Richard Fiedotin’s Rule 1.131 Declaration describe that the Applicants diligently pursued the invention up to September 22, 1999, when they met with the undersigned attorney. For example, paragraph 12 describes diligence from June 30, 1999, paragraph 13 describes diligence from July 1-14, 1999, paragraph 14 describes diligence from July 15-31, 1999, paragraph 15 describes diligence dated on July 19, 1999, paragraph 16 describes diligence on July 20, 1999, paragraph 17 describes diligence on July 26, 1999, paragraph 18 describes diligence on July 30, 1999, paragraph 19 describes diligence between August 6-September 21, 1999, paragraph 20 describes diligence on August 31, 1999, paragraph 21 describes diligence on September 7, 1999, paragraph 22 describes diligence on September 15, 1999, and paragraph 23 describes diligence on September 22, 24 and October 1, 1999.

Moreover, the attached declaration of the undersigned attorney shows

reasonable attorney diligence from September 22, 1999, to January 20, 2000.

Consequently, the above Declarations satisfy 37 C.F.R. § 1.131 by showing conception prior to July 1999, diligence from prior to July 1999, up until the constructive reduction to practice of the invention on January 20, 2000. Thus, the publications made of record by the Examiner have effectively been removed as 35 U.S.C. § 103(a) references. Accordingly, a prima facie case of obviousness cannot be established using the above cited references. Therefore, it is respectfully requested that the above rejections be withdrawn and all pending claims be allowed.

A fee for an extension of time is believed to be due for this submission and a petition for extension of time is submitted concurrently herewith. The Examiner is authorized to charge these fees and any other fees required at this time to (10160-0007-999) Pennie & Edmonds LLP's Deposit Account No. 16-1150.

Date: March 21, 2003

Respectfully submitted,


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